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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,382	12/08/2003	Jean-Charles Souriau	9905/18	4537
757	7590	09/01/2005	EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			CHIAM, DINH D	
			ART UNIT	PAPER NUMBER
			2883	

DATE MAILED: 09/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/731,382

Applicant(s)

SOURIAU, JEAN-CHARLES

Examiner

Erin D. Chiem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

This office action is made in response to Applicant's initiated telephonic interview made on June 20, 2005. The Examiner prosecuted the application on the original set of claims rather than the preliminarily amended set of claims. In view of these amendments, it is now deemed that a restriction requirement is in order.

Election/Restrictions

- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-18, drawn to a passively aligned optical arrangement, classified in class 385, subclass 52.
 - II. Claims 19-23, drawn to the method of producing the passively aligned optical module, classified in class 438, subclass 108.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case (2) the "bumps" formed on the substrates, as taught by Applicant, can be formed by micro molding. Furthermore, Applicant's recitation of Claim 1 seems inaccurate because the structure exists only during intermediate step and does not exist in the finished end-product device.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species A, embodiment 1, Fig. 1, drawn to a passively aligned optical arrangement wherein there is only one optical component, disregarding the optical fibers, disposed between the first and second plate as described in the Specification, page 3 line 21- page 4 line 8.

The sub-species of Species A are as follows:

Sub-Species B, embodiment 1, Fig. 1, drawn to a passively aligned optical arrangement wherein the optical component disposed between the two plates is an optical filter, Specification page 11 line 1-7.

Sub-Species C, embodiment 1, Fig. 1, drawn to a passively aligned optical arrangement wherein the optical component disposed between the two plates is a variable optical attenuator, Specification page 11 line 8-12.

Sub-Species D, embodiment 1, Fig. 1, drawn to a passively aligned optical arrangement wherein the optical component disposed between the two plates is a magneto-optical isolator, Specification page 11 line 13.

Sub-Species E, embodiment 1, Fig. 1, drawn to a passively aligned optical arrangement wherein the optical component disposed between the two plates is a micro-mirror, Specification page 11 line 14.

Sub-Species F, embodiment 1, Fig. 1, drawn to a passively aligned optical arrangement wherein the optical component disposed between the two plates is an electro-optic modulator, Specification page 11 line 15-19.

Sub-Species G, embodiment 1, Fig. 1, drawn to a passively aligned optical arrangement wherein the optical component disposed between the two plates is a network of micro-lenses, Specification page 11 line 18-19.

Sub-Species H, embodiment 1, Fig. 1, drawn to a passively aligned optical arrangement wherein the optical component disposed between the two plates is a wavelength-selective photodetector, Specification page 11 line 20-25.

Sub-Species I, embodiment 1, Fig. 1, drawn to a passively aligned optical arrangement wherein the optical component disposed between the two plates is an optically pumped solid state or semiconductor laser cavity or linear array of laser cavities, Specification page 11 line 26-29.

Species J, embodiment 2, Fig. 2, drawn to a passively aligned optical arrangement wherein there are two optical components, disregarding the optical fibers, disposed between the first and second plate as described in the Specification, page 4 line 10-page 5 line 8.

The sub-species of Species J are as followed:

Sub-Species K, embodiment 2, Fig. 2, drawn to a passively aligned optical arrangement wherein the optical component disposed between the two plates is an optical filter, Specification page 11 line 1-7.

Sub-Species L, embodiment 2, Fig. 2, drawn to a passively aligned optical arrangement wherein the optical component disposed between the two plates is a variable optical attenuator, Specification page 11 line 8-12.

Sub-Species M, embodiment 2, Fig. 2, drawn to a passively aligned optical arrangement wherein the optical component disposed between the two plates is a magneto-optical isolator, Specification page 11 line 13.

Sub-Species N, embodiment 2, Fig. 2, drawn to a passively aligned optical arrangement wherein the optical component disposed between the two plates is a micro-mirror, Specification page 11 line 14.

Sub-Species O, embodiment 2, Fig. 2, drawn to a passively aligned optical arrangement wherein the optical component disposed between the two plates is an electro-optic modulator, Specification page 11 line 15-19.

Sub-Species P, embodiment 2, Fig. 2, drawn to a passively aligned optical arrangement wherein the optical component disposed between the two plates is a network of micro-lenses, Specification page 11 line 18-19.

Sub-Species Q, embodiment 2, Fig. 2, drawn to a passively aligned optical arrangement wherein the optical component disposed between the two plates is a wavelength-selective photodetector, Specification page 11 line 20-25.

Sub-Species R, embodiment 2, Fig. 2, drawn to a passively aligned optical arrangement wherein the optical component disposed between the two plates is an optically pumped solid state or semiconductor laser cavity or linear array of laser cavities, Specification page 11 line 26-29.

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Applicant is required under 35 U.S.C. 121 to elect Invention II or Invention I. If Applicant chooses to elect Invention I, Applicant must further elect Species A and one corresponding Sub-species B-I or Species J and one corresponding Sub-species K-R. The election of the single disclosed invention and species is for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

A telephone call was made to Attorney Bill Dockrey on June 20, 2005 to request an oral election to the above restriction requirement, but did not result in an election being made.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erin D. Chiem whose telephone number is (571) 272-3102. The examiner can normally be reached on Monday - Thursday 9AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank G. Font can be reached on (571) 272-2415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Erin D Chiem
Examiner
Art Unit 2883



Frank G. Font
Supervisory Primary Examiner
Technology Center 2800

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